

PATENT
Serial No. 10/757,796
Attr. Docket No. 035372-003

In the Drawings

The attached drawing FIGS. 1 and 2 are identical to the originally filed drawings and are intended to be the drawings associated with this application. They are re-submitted herewith.

Attachment: Replacement sheet(s)

AUG 15 2007

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The Office Action mailed January 3, 2007 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Drawings

The attached drawing figures FIGS. 1 and 2 are identical to the originally filed drawings and are intended to be the drawings associated with this application. They are re-submitted with this response in order to clarify any confusion between these original drawing figures FIGS. 1 and 2, and a different set of drawing figures FIGS. 1 and 2 that were submitted separately as part of a declaration by Jon Taenzer. The drawings that were submitted as part of the declaration were intended only to support the declaration, and not as part of the application drawings.

Election Requirement

Applicants affirm the election, without traverse, to prosecute the invention of Group I, Claims 1-13 and 24-26. Applicants reserve the right to pursue the patentability of the subject matter of the non-elected claims.

Art-Based Rejection(s)

Claims 1-2 and 6-8 were rejected under 35 U.S.C. § 102(e) as anticipated by Nassimi (U.S. pat. no. 7,079,664). Claims 1 and 10-12 were rejected under 35 U.S.C. § 102(b) as anticipated by French (U.S. pat. no. 2,545,731). Claims 24-26 were rejected under 35 U.S.C. § 102(b) as anticipated by Topholm (U.S. pat. no. 4,585,089). Claims 3-5, 9 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nassimi (U.S. pat. no. 7,079,664).

Independent Claims 1 and 24 have been amended to recite, *inter alia*, "a rotatable cap configured to adjustably direct sound from the speaker away from the direction of the speaker axis towards the ear canal of a user." (Claim 1). Support for these features can be found in the original claims and for example in ¶¶[0020] and [0024]-[0025] of the specification. These features are neither disclosed nor suggested by Nassimi, French or Topholm, considered

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singularly or in combination. It will be appreciated that, according to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102 only if each and every claim element is found, either expressly or inherently described, in a single prior art reference.¹ The aforementioned reasons clearly indicate the contrary, and withdrawal of the 35 U.S.C. § 102 rejection based on Nassimi, French and Topholm is respectfully urged. It will further be appreciated that according to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.²

Newly-Added Claims

Claims 27-31 have been added to further particularly point out and distinctly claim the subject matter regarded as the invention.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

¹ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).


² M.P.E.P § 2143.

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Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Amendment and/or Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-1698.

Respectfully submitted,
THELEN REID BROWN RAYSMAN & STEINER LLP

Dated: 07/03/2007



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